

REMARKS

This is in response to the Action of August 12, 2009. The Office Action indicated that claims 164-221 were pending and that claims 164-221 were rejected.

By this amendment applicant has amended claim 164 to expressly recite that the “selecting” occurs on the “keypad of the wireless device” and that the function code is transmitted “from the wireless device” and received at “said central processing unit” which also effects the “determining”. Claims 170, 176, 182, 188 and 194 have been amended to include some of the same subject matter. Claim 201 is amended to indicate that the received message is received “from the wireless device”. Claims 206, 211, 216 and 221 have been amended in a similar fashion. The drawings and specification of the application clearly support these amendments. Similar amendments are made to dependent claims 166, 203, 208, 210, 213 and 218. Finally claim 197 is amended to correct a word omission. Applicant submits there is no new matter involved in these amendments.

In the first rejection, claims 164-221 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite. The basis for the rejection was explained in connection with claim 164 as exemplary. The rejection identifies four different aspects in which claim 164 is allegedly indefinite.

First, the action focuses on the limitation “preparing the wireless device to engage in a funds transfer transaction” and alleges that this recitation makes the claim vague and unclear. The MPEP, at §2173.02, provides that:

“The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity.... In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the

claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent".

Applicant submits that "preparing the wireless device to engage in a funds transfer transaction" does give clear warning to the public about the activities which will constitute infringement of the patent. The drawings and specification provide examples of the activities which come within the scope of the claim, see figs 1A, (Ready cell phone for transaction/activity) and the specification at 4:49-51, fig. 2A (Activate or clear cell phone/pcs, ready cell phone for tolling) and the specification at 7:13-14; 10:29-30. The rationale found in the action, that the phrase is "unclear since it fails to particularly point out what is being done to prepare the wireless device so it is engaged in a funds transfer process" is not at all convincing. Applicant asserts that the analysis found in the rejection goes to the breadth of the preparing clause and not its definiteness. As the MPEP points out (§2173.04) breadth is not indefiniteness. The claim provides applicant with a reasonable claim scope; the scope does not render the claim indefinite. Applicant submits that this phase of the rejection should be reconsidered and withdrawn.

Second, the Office Action alleges that the phrase "user selection of a desired funds transfer" is vague "since a user desired funds transfer covers any type of funds transfer without any limits"¹. Applicant submits that the selecting a function code step merely ties the function code which is selected to the user's desire to effect "a desired funds transfer". Applicant submits that this clause of the claim does circumscribe a particular subject with a reasonable degree of

¹ The phrase which is singled out in this phase of the rejection calls for "selecting a function code corresponding to user selection of a desired funds transfer on the keypad of the wireless device".

clarity, and that is all that is required by the second paragraph of section 112. Applicant submits that this clause does serve the notice function of a claim by informing the public what will constitute infringement. In view of the foregoing Applicant requests reconsideration and withdrawal of this phase of the rejection.

Third, the action alleges that a user cannot select a function code unless he is given a list of function codes to choose from. The rejection argues that “the claim omits essential step of providing a list of function codes which correlate to a desired funds transfer transaction” and alleges that the omission amounts to a gap between the steps relying on §2172.01 of the MPEP. However, § 2172.01 describes a rejection under 35 U.S.C. 112, first paragraph, not a rejection under 112, 2nd paragraph. In any event, Applicant submits that the failure to specify providing a user with a list of function codes does not amount to the omission of essential matter for a number of reasons. The suggestion that the user requires function code information and the only way to supply that information is via the provision of a list ignores other ways for providing required information which are just as effective. For one thing the user does not need a list – if the user only engages in a single transaction a list would be unnecessary. Even if the user regularly engages in more than a single type of transaction the user may have memorized the function code(s) relating to a few transactions which the user expects to engage in. In that event providing a list is unnecessary. Alternatively, a relevant function code may be posted at a particular location or may be printed on the communication device. Still further if the user is engaging in a commercial transaction, his vendor may provide information respecting the function code which relates to the transaction that may be engaged in. Thus limiting the claims to include a step of providing the user with a list of function codes at the time the transaction is enabled would be unduly limiting and has been shown not to be essential. In view of the

foregoing applicant asserts that limiting the claim in the manner required in the action would unduly limit the scope of protection afforded by any patent. In view of the foregoing Applicant submits that the rejection (whether it is based on the first or second paragraph of §112) be reconsidered and withdrawn.

Finally, the Office Action indicates that the “without further addressing” clause in the claim is indefinite because it is recited “without any reference (or relationship) to the function code or the wireless device”. To the contrary, however, the attached Morrill declaration under Rule 132 indicates that the “without further addressing” does have a relationship to the transmitting step. For example the Specification describes:

This procedure is carried out by the user first entering a unique function code on the devices keypad to identify the type of transaction or activity desired and pressing “SEND”. The mobile phone service providers cpu identifies the desired transactions and determines if the transaction involves a default amount (as in a pre-set price for a specific highway toll plaza, transit fare, or vending machine), which is displayed on the phones LED screen along with an “OK?” prompt.” (2:34-43).

As noted in the Morrill declaration (¶7-8) those skilled in the art know that the transmission caused by pressing the “send” button inherently involves addressing. The fact that the service provider CPU is identified in the very next sentence of the specification as receiving the message makes it apparent that there is “no further addressing” beyond the addressing which is occasioned by enabling the send key. This same relationship is evident from figure 1b for example when the two acts of entering a unique function code and pressing the send key appear in a block and the very next action indicates that the “CPU” determines amount of entry needed. Clearly this is the service provider’s CPU which is identified in the portion of the specification reproduced. Thus the “without further addressing” is certainly connected to the wireless device.

In view of the foregoing reconsideration and withdrawal of the rejection of claims 164-221 under 35 U.S.C. § 112, second paragraph is solicited.

Claims 164-221 are also rejected under 35 U.S.C. § 112, first paragraph. The rejection is based on the allegation that the “without further addressing” clause is subject matter which was not described in the specification in such a way to reasonably convey to those skilled in the relevant art that the inventor had possession of the claimed invention. The rejection is supported by alleging “this limitation is a negative limitation since it excludes addressing other than function code as best understood by the Examiner in light of the 112 (second) deficiencies outlined *supra*”.

To the contrary the function code, which is transmitted by the wireless device, does not take part in any addressing. As explained in the Morrill declaration (¶7-8):

The action (transmission from the user’s communication device to the service provider’s CPU) occurs after the user’s selection of the function code and specifically in response to the act of pressing “send”. Those skilled in the art are aware that when a cellular communication device, such as a cell phone, is commanded to communicate in response to activation of a “send” key, communication takes place per the type of message selected for that communication.

While there are various procedures for message type selection (e.g. by user, by device, or by protocol or system convention), what is important across all the different kinds of devices is that there is a determination of the message type. Message type selection, preparatory to transmission includes channel selection. In other words when a message type is determined the communication device also determines whether the channel needs to be changed or not. This channel determination is a form of addressing in that by channel selection the transmission of information is addressed to device(s) or recipients (in this case the mobile service provider’s CPU) which is/are configured to receive that type of message on the selected channel. Since the specification makes it clear the transmission function occurs in response to the activation of the “send” key and since those skilled in the art are aware of the message type and channel selection (i.e., addressing) and transmission occasioned by activating the “send” key, it should be apparent that those skilled in the art would immediately recognize that in this procedure there is “no further addressing”, i.e. “no further addressing” beyond the channel selection, just as is claimed.

As noted in the Morrill Declaration those skilled in the art know that the transmission caused by pressing the “send” button inherently involves addressing. The fact that the service provider CPU is identified in the very next sentence as having received the message makes its apparent that there is “no further addressing” beyond the addressing which is occasion by enabling the send key. This same relationship is evident from figure 1b for example when the act of pressing the send key and the very next action indicates that the “CPU” determines amount of entry needed. Clearly this is the service provider’s CPU which is identified in the portion of the specification referred to. The CPU responds since the message is addressed to it, via the act of pressing the send key, without further addressing.

It should be noted that the rejection relies on *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App.& Inter. 1993). A copy of the opinion in Ex parte Parks is attached.

In *Ex parte Parks* the Board noted:

The initial burden of establishing a *prima facie* bases to deny patentability to a claimed invention on any ground is always upon the Examiner In rejecting a claim under the first paragraph of 35 U.S.C. § 112 for lack of adequate descriptive support, it is incumbent upon the Examiner to establish that the originally-filed disclosure would not have reasonably conveyed to one having ordinary skilled in the art that an appellant had possession of the now claimed subject matter.

The rejection specifically notes, as does *Parks*, that:

Adequate description under the first paragraph of 35 U.S.C. 112 **does not require literal support** for the claimed invention.

and

Clearly, the observation of **a lack of literal support does not, in and of itself, establish a prima facie case for lack of adequate descriptive support** under the first paragraph of 35 U.S.C. 112. *In re Herschler*, supra; *In re Edwards*, supra; *In re Wertheim*, supra. (emphasis added)

In other words the mere fact that the words “without further addressing” or their equivalent do not appear in the specification is not a basis for a rejection of the claims under 35 U.S.C. § 112, first paragraph. In order to support the rejection there must be some other reasoning to justify the rejection. Applicant does not see any such reasoning in the rejection. Further as indicated in the Morrill declaration the presence of “addressing” is inherent in the application as filed. As such the “without further addressing” is amply supported by the specification. Applicant submits that in light of the Morrill Declaration, the meaning of the phrase and its support in the originally filed application should be apparent. Reconsideration and withdrawal of the rejection is solicited.

The Office Action objected to the claims for two reasons. The status of the original claims² is not indicated and the newly added claims are not underlined. Both objections have been overcome in this amendment. The amendment does indicate the status of the original claims and does show all pending claims with underlining. Applicant has also attached at the end of these remarks, as an appendix, a version of the pending claims which shows the amendments made by this amendment.

The claims are also rejected under 35 U.S.C. § 251. Applicant appreciates the Examiner’s thorough analysis and has provided a Substitute Reissue Declaration to overcome the basis for the rejection. The substitute reissue declaration now sets forth exactly how the error arose in that all claims in the original patent were unnecessarily limited. The declaration goes further and describes how the appended claims overcome that error. In addition, the rejection required an explanation of the support in the specification for the claims. Attached as an

² Applicant notes that the original patent includes claims 1-8 and that an earlier reissue application (now reissue patent Re 39,736) includes the original claims 1-8 as well as reissue claims 9-98.

appendix to this amendment is a table mapping the support in the specification for recitations in all the pending claims. In view of the foregoing reconsideration and withdrawal of the §251 rejection is solicited.

Claims 164-221 were also rejected under 35 U.S.C. § 101 “because the claimed invention is directed to non-statutory subject matter”. The rejection acknowledges that process claims are statutory if tied to another statutory class such as a particular apparatus or machine, relying on *In re Bilski*. The rejection alleges that “none of the process steps of the method claims are tied to an apparatus such as a computer...” Several of the claims have been amended so as to make explicit what Applicant believed was already implicit in the claims. Specifically that the claimed method is tied to at least one physical device. For example, in claim 164 the selecting step has been amended to recite that the selecting occurs “on the keypad of the wireless device”. Similarly, the transmitting step has been amended to indicate that the transmitting occurs “from the wireless device”. Likewise, the authorizing step has been amended to indicate that in response to receipt of the function code and user identification the authorizing occurs “at said central processing unit”. Similarly, claim 170 is amended to specify in the sending step that the sending is “from the wireless device”. Likewise, the determining step has been amended to indicate that the determining occurs “at the central processing unit”. Claims 176, 182, 188 and 194 are amended in a similar fashion.

Claim 196, as rejected recites, “receiving from the wireless device a message...”. Applicant submits that this claim cannot be characterized as one which is devoid of some tie to another statutory class. Applicant requests reconsideration and withdrawal of rejection with respect to claim 196 and its dependent claims. Finally, claims 201, 206, 211, 216 and 221 have been amended to specify that the receiving occurs “from the wireless device” Applicant submits

that these claim can no longer be alleged to be claims which are devoid of a tie to another statutory class, such as a recitation of a particular apparatus. In view of the amendment and the foregoing remarks, reconsideration and withdrawal of the rejection of claims 164-221 under 35 U.S.C. § 101 is solicited.

The Office is authorized to charge any necessary fees to Deposit Account No. 22-0185.

Applicant believes no further fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 22-0185, under Order No. 05525-00003-US1 from which the undersigned is authorized to draw.

Dated: January 12, 2010

Respectfully submitted,

Electronic signature: /Stanley B. Green/
Stanley B. Green
Registration No.: 24,351
CONNOLLY BOVE LODGE & HUTZ LLP
1875 Eye Street, NW
Suite 1100
Washington, DC 20006
(202) 331-7111
(202) 293-6229 (Fax)
Attorney for Applicant